

REMARKS

Response to Amendment

The applicant appreciates the Examiner entering the amendment filed May 22, 2006.

Claim Rejections

Claims 1-2, 11-13 were rejected as being obvious and unpatentable over Weiner et al., U.S. Patent No. 6,696,004 in view of Lussi et al., U.S. Patent No. 5,015,516. Weiner teaches the process for making a vinyl sheet product which places the first vinyl layer **20** onto a conveyor and imbedding a decorative mesh material **26** into the vinyl layer and curing the vinyl layer to form the vinyl sheet as described by the Examiner. Lussi teaches the provision of providing a substrate and then providing drips **onto** the substrate to create a vinyl product.

In claims 1, a method of creating a vinyl product requires depositing design material onto a conveyor in the form of drips, streams, chips and pellets and then applying a vinyl substrate layer over the design material with at least a portion of the design material remaining in contact with the conveyor. This specific limitation is taught nowhere in either the '004 Weiner et al. or the Lussi et al. '516 references. It is only with hindsight and the use of the applicant's specification and claims that such a rejection can be formulated. Accordingly, this rejection fails to meet the requirement for a *prima facie* case of obviousness and should be withdrawn since elements from claim 1 are only found in the claim and not in the cited references.

As it relates to claims 15-17 and 19, the claims as affected by the previous amendment requires the design material to extend into at least the upper surface of the first vinyl substrate layer. This is certainly a much closer obviousness issue than for claim 1 since at least the particles, chips, or dry blends as described in the '516 Patent are laid on 'a substrate and sintered

by heat', or 'laid in' a transparent liquid or solid matrix and fused by heat." (Col. 35, lines 38). However, the applicant is still unable to find a reference in the '516 Patent whereby particles are at least partially imbedded into a portion of a substrate layer instead of being placed on top or within a separate layer. While the Weiner et al. patent does teach the imbedding of a mesh into a substrate, the applicant believes it is only with the applicant's present disclosure and instead of reading the two references independent of the application at issue to find a motivation to combine those together to find the claimed subject matter. Imbedding particulate and imbedding mesh would require somewhat different approaches since mesh is normally continuous and particulate is discontinuous. Accordingly, as it appears that in the absence of a teaching to imbed particulate as it relates to claims 15-17 and 19, these claims are also believed to be allowable.

Claims 3 and 18 were rejected as being obvious over the combination described above as well and further combination of Weiner, U.S. Patent No. '033. Weiner '033 teaches sandwiching mesh intermediate vinyl layers to create a desired visual effect.

These claims depend from independent claims 1 and 2 which as discussed above, are not believed to be rendered obvious and therefore can stand or fall with their respective claims. If an appeal is necessary, then separate grounds of allowance may be provided at that point in time as it relates to these claims.

Claims 4-5 and 20 are rejected as being obvious over Weiner '004 in view of Lussi et al. '516 and further view of Erb, U.S. Patent No. 3,350,483. As it relates to claim 20, the Erb reference is believed to be particularly illustrative of a rationale as to why the claims are not rendered obvious instead of providing a rationale for rejecting the claims. Specifically, as can be seen in Figures 3 and 4 of Erb, the design material sits on top of background coating **23** and is not imbedded into it. Accordingly, limitations of claim 20 cannot be met.

As it relates to claim 4 and 5, the asbestos felt web W is located below even the substrate so there is no way for the design material to contact a conveyor as required by claim 1.

Accordingly, the Erb reference explicitly teaches away from the process of claim 1 as does the Lussi reference and the Weiner reference. The three references combined together are also not believed to be capable of teaching one skilled in the art to perform the claimed methods.

The rejection of claims 6-10 is extremely confusing to follow due to the complexity of how the specific references are combined. The Hensler et al reference shows that it may be possible to provide the two different colors of a vinyl substrate together at a uniform thickness. However, Hensler does not provide all of the claim limitations even when taken together with the other references. Furthermore, these claims depend from what is believed to be an allowable claim 1.

Claim 14 was rejected as being obvious over the combination of Weiner, Lussi in further view of Suzuki et al., U.S. Patent No. 6,589,631. Neither Weiner, Lussi nor Suzuki teaches the element as described above as it relates to claim 1 from which this claim depends. No additional arguments are believed to be necessary as it relates to this claim, but if an appeal is necessary, it is likely that an additional ground of allowance will be provided for this claim as well.

Conclusion

This is believed to be a complete response to the Office Action of August 8, 2006 and allowance of the claims is respectfully requested.

Respectfully submitted,

Date: Nov 29, 2006

By: 

✓ Stephen J. Stark

Reg. No. 43,152

Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope with sufficient first-class postage addressed to:

Mail Stop Fee Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

on this 29th day of November, 2006.

By: Beverly L. Middleton
Beverly L. Middleton